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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,991	12/06/2001	Yuuji Saiki	020606	3509
38834	7590	11/07/2005	EXAMINER	
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			LAVARIAS, ARNEL C	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

Office Action Summary	Application No.	Applicant(s)	
	10/015,991	SAIKI ET AL.	
	Examiner	Art Unit	
	Arnel C. Lavarias	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/31/05, 4/29/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 13, 16-20, 22-28 and 30-35 is/are pending in the application.
- 4a) Of the above claim(s) 5-8, 13, 16-20, 22-26, 30, 31 and 33-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9, 10, 27, 28 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Invention I (Claims 1-4, 9-10, 17-20, 22-28, 32) in the reply filed on 8/31/05 is acknowledged.
2. Claims 5-8, 13, 16, 30-31, 33-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/31/05.
3. Claims 17-20, 22-26 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions within Invention I is required under 35 U.S.C. 121:
 - IA. Claim 2, drawn to an optical member, wherein the protective film is disposed on one surface of the optical material, and a separator is provided on an adhesive layer disposed on the other surface of the optical material so that the separator can be released from the adhesive layer, classified in Class 428, subclass 41.8.
 - IB. Claims 17-20, 22-26, drawn to an optical member, wherein the polarizing plate has a transparent protective layer on one or both faces of a polarizing film, classified in Class 349, subclass 96; Class 359, subclass 483.

The inventions are distinct, each from the other because of the following reasons:

Inventions IA and IB are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, all of the subcombinations have separate utility in a combination without the particulars of the other subcombinations. See MPEP § 806.05(d).

Claim 1 link(s) inventions IA and IB. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), Claim 1. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

In addition, Claims 3-4, 9-10, 27-28, and 32 will be examined along with the elected invention only if Invention IA or IB is elected.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group IA is not required for Group IB, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Since applicant has received an action on the merits for the originally presented invention (Invention IA, Claim 2), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claims 17-20, 22-26 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. Claims 1-4, 9-10, 27-28, and 32 will be examined on the merits as being drawn to the elected invention (i.e. Invention 1A).

Response to Arguments

5. The declaration under 37 CFR 1.132 filed 4/29/05 is insufficient to overcome the rejection of claims of Claims 1 and 5 based upon 35 U.S.C. 103(a) as set forth in the last

Office action because: The declaration filed 4/29/05 includes quantitative data regarding various protective films having an outer surface roughness Ra that varies from 0.02-3.95 μm . Applicants believe that the experimental data provides support for films having an Ra greater than 2 μm being insufficient in transparency. However, the Examiner notes that particular optical properties of the protective film, such as haze or transparency properties, are not recited in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In addition, as previously set forth in Section 4 of the Office Action dated 8/26/04, the 2-10 μm surface roughness range disclosed by Arakawa et al. is merely exemplary. Arakawa et al. specifically discloses that the surface roughness of the film should not be more than $\frac{1}{2}$ (and preferably be between $\frac{1}{4}$ and $\frac{1}{10}$) the physical thickness of the film. Arakawa et al. specifically discloses the physical thickness of the film being 25 μm or less (See col. 2, lines 26-50 of Arakawa et al.). Thus, one of ordinary skill would expect the surface roughness of the film to be approximately in the range of 0-12.5 μm , which overlaps the claimed 0.03-1 μm range.

6. Claims 1-4, 9-10, 27-28, 32 are rejected as follows.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 9-10, 27-28, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagahama et al. (WO00/44841), of record, in view of Arakawa et al. (U.S. Patent No. 5972473), of record.

Nagahama et al. discloses an optical member (See Figure 7) in which a surface of an optical material (See 15, 16 in Figure 7) is bonded to and covered with a protective film (See 11, 12 or 14, 11 in Figure 7), wherein the protective film comprises a protective base and an adhesive layer disposed on the protective base so that the protective base can be released together with the adhesive layer from the optical material (See Abstract; 11, 12 or 11, 14 in Figure 7). Nagahama et al. additionally discloses the protective film being disposed on one surface of the optical material (See for example 11, 12 in Figure 7), a separator being provided on an adhesive layer disposed on the other surface of the optical material (See 11, 14 in Figure 7) so that the separator can be released from the adhesive layer (See 17 in Figure 7), the optical material comprising a polarizing plate (See 16 in Figure 7), a liquid display having the optical member (See Abstract); the protective film thickness not being more than 300 μm (See for example Page 7 (Page 14 of translation), as well as various disclosed examples of the protective film on Pages 17-27 (Pages 31-47 of the translation)); and the protective film being a light-transmitting protective film (See Abstract; various examples disclosed). Nagahama et al. lacks the protective film having an outer surface roughness Ra of from 0.03 to 1 μm . However, Arakawa et al. teaches the use of a protective plastic film that has a matte or embossed surface (See for example Figure 4), the protective plastic film being used as a separator or protective film (See

Abstract). In particular, Arakawa et al. teaches that the outer surface of the protective film may have a surface roughness Ra (which is typically 2-25 microns for exemplary film thicknesses of 20-50 μm) that is at most $\frac{1}{2}$ of the protective film thickness and generally is 25 μm or less (See col. 2, lines 26-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the protective film of Nagahama et al. exhibit an outer surface roughness Ra of from 0.03-1 μm , as taught by Arakawa et al., for the purpose of reducing the friction coefficient of the surface of the film.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagahama et al. in view of Arakawa et al. as applied to Claim 1 above, and further in view of Iwata et al. (U.S. Patent No. 6111699), of record.

Nagahama et al. in view of Arakawa et al. discloses the invention as set forth above in Claim 1, except for the optical material further including at least one of a retardation plate and a brightness enhancement plate. However, Iwata et al. discloses an optical member (See for example Figures 6B, 7, 11) in which an adhesive layer (See 34 of Figure 6B) disposed on an outermost surface of an optical material (See 12 in Figure 6B) is provisionally bonded to and covered with a separator (See 36 in Figure 6B). Iwata et al. additionally discloses the separator being disposed on one surface of the optical material (See Figures 6B, 7), a protective film being provided on the other surface of the optical material (See 18, 32 in Figures 6B) having an outer surface roughness Ra of at least 0.03 μm (See Abstract; col. 5, lines 50-65), the optical material comprising a polarizing plate and at least one of a retardation plate and a brightness enhancement plate (See for

example 42 in Figure 7; 42, 86 in Figure 11), and a liquid display having the optical member (See for example col. 10, line 25-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the optical material further include at least one of a retardation plate and a brightness enhancement plate, as taught by Iwata et al., in the optical member of Nagahama et al. in view of Arakawa et al., for the purpose of reducing the cost and complexity of manufacturing the liquid crystal display panel.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2872

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 571-272-2315. The examiner can normally be reached on M-F 9:30 AM - 6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arnel C. Lavarias
11/3/05



**THONG NGUYEN
PRIMARY EXAMINER
GROUP 2800**